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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/542,399	07/14/2005	Gregory J Kelly	STA-1	1753				
<div>63704 7590 05/09/2008 HESS PATENT LAW FIRM, P.C. 9 MIRAMAR LANE STAMFORD, CT 06902</div>								
<div>EXAMINER PUROL, SARAH L</div>								
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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MAY 08 2008

TECHNOLOGY CENTER 3600

Hess Patent Law Firm, P.C.
9 Miramar Lane
Stamford, CT 06902

In re Application of:
Gregory J. Kelly
Serial No. 10/542,399
Filed: July 14, 2005
For: Truncated Pyramidal Golf Ball
Positioning Device

:
: DECISION ON PETITION
: FOR WITHDRAWAL OF
: REQUIREMENT FOR
: RESTRICTION AND
: WITHDRAWAL OF FINALITY

Applicant's petition, filed on February 06, 2008, requests withdrawal of the restriction requirement and the finality of the action dated January 16, 2008 as being improper.

The petition is **GRANTED**.

Applicant alleges that the restriction requirement was improper because the claims 1-19 as amended by the amendment filed on January 18, 2008 are not restrictable according to MPEP 806.05(c). In addition, applicant alleges that the final rejection dated January 16, 2008 was improper because the amended claims 1-19 were not drawn to the same invention, and said claims would not have been properly rejected on the grounds and art of record if they have been entered in the earlier application.

A review of the application reveals that claims 1-19 were amended in an amendment after final on October 10, 2007 in which applicant changed the scope of claim 1 from a subcombination of a "golf ball positioning device" to a combination of a "golf ball positioning device" and "golf balls". An advisory action was issued on October 29, 2007 in which the examiner indicated that the proposed amendment was not deemed to place the application in better form for appeal and thus will not be entered.

Subsequently, applicant filed a Request for Continued Examination on October 31, 2007 in which the previously submitted amendment after final was entered. The examiner then issued a final rejection on January 16, 2008 indicating that the amended claims 1-19 are directed to the combination of a golf ball positioning device and golf balls, which is distinct and independent from the device originally claimed. The rationale for the restriction was that the combination is an invention within the prevue of class 206 and not class 211. The examiner went on and made the action final alleging that all claims are drawn to the same invention in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they have been entered in the earlier application.

On January 18, 2008 applicant filed an after final amendment in which a request for reconsideration of the restriction and a request for reconsideration of the finality were made. The examiner issued an advisory action on February 08, 2008 stating that the requests for reconsideration have been considered but the claims do not overcome the prior art rejection. On February 22, 2008 applicant filed a second after final amendment in which claim 1 was further amended. The examiner denied entry of this amendment in an advisory action issued on March 20, 2008.

It is noted that the examiner was correct in determining that the amendment after final filed on October 10, 2007 changed the scope of claims 1-19 to a combination by positively claiming the golf balls. However, applicant was correct in his argument set forth in the petition that since the combination claims require all the details of the positioning device of the subcombination as separately claimed in the version filed on June 25, 2007 the inventions are not distinct and the restriction requirement must not be made or maintained. See MPEP 806.05(c).

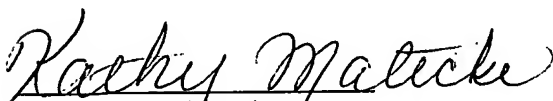
As for the applicant's argument that the finality of the rejection was improper, it is noted that the examiner denied entry of the after-final amendment filed October 10, 2007. This amendment was entered along with the RCE on October 31, 2007. Since an Office action following such an amendment cannot be made final (MPEP 706.07(b)), the final rejection issued on January 16, 2008 following the RCE is improper.

As for applicant's argument that the combination as claimed was not properly classified in class 211, the argument is moot in view of the fact that the restriction requirement was improper.

Based on these facts, it is determined that the both the restriction requirement and the finality of the rejection were improper. The amendment after final filed on February 22, 2008 will be entered and the finality will be withdrawn. The application will be returned to the examiner for issuing a non-final Office action on the merits of claims 1-19 as filed on February 22, 2008.

SUMMARY: The petition is GRANTED.

Any questions regarding this decision should be directed to SPE Lanna Mai at 571-272-6867.


Kathy Matecki, Director
Technology Center 3600
(571) 272-5250

lm/sm: 4/28/08

